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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/486,536	07-95	HIATT	A 214/177

HM32/0914
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EXAMINER	
WILSON, J	
ART UNIT	PAPER NUMBER
1623	78

DATE MAILED: 09/14/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on July 6, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 (Three) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-8 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-8 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 116
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

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- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

Art Unit: 1623

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-8 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1-6 of prior U.S. Patent No. 5,763,594. This is a double patenting rejection.

Please note that the invention of claims 1-8 of the instant 08/486,536 are seen to include all of the limitations of the patented claims in Patent No. 5,763,594. See specifically where the 5'-nucleoside phosphate has a removable moiety at the 3'-position which is selected from the same group of "blocking moieties".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

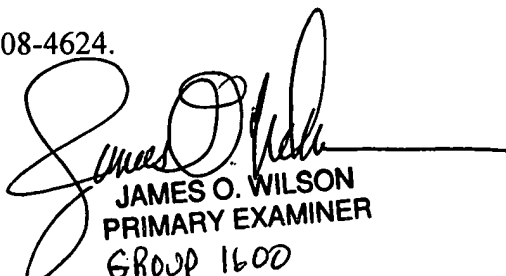
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1623

Claims 1-3 are confusing because they each reference the compound as a 5'-phosphate compound, however, in the last line of each claim, the compound alludes to a second (by including the terminology "said") mentioning of a 5'-triphosphate. There is no first reference to a 5'-triphosphate compound and the term lacks antecedent basis. If applicant intends for the first mentioned phosphate compound to be a 5'-triphosphate, then the claims should be amended to reflect same. None of the subsequent dependent claims clarifies this issue. In claim 4, the phrase "nucleoside of 5'-triphosphate" is awkward and ambiguous, rendering claim 4 indefinite. Claim 5 references the first 5'-phosphate from claims 1-3 and intends for it to be a triphosphate, however the last line of the claims implies that the 5'-phosphate is a 5'-triphosphate. This claim either fails to limit the claims from which it depends or is a duplicate and should be canceled. Claim 6 fails to further limit the phosphate compound of claims 1, 2 or 3 since subsequent procedural actions upon the compound fail to further limit the compound itself. Likewise, claims 7 and 8 fail to further limit the identity of the compound claimed. Subsequent time constraints and attachments of the actual removable protecting group are not seen as further limiting of the compound itself.

Any inquiry concerning this communication should be directed to James O. Wilson,
Primary Examiner in Art Unit 1623 at telephone number (703) 308-4624.



JAMES O. WILSON
PRIMARY EXAMINER
GROUP 1600